

REMARKS/ARGUMENTS

Claims 4-9 have been amended; claims 1-3, 10 and 14-18 have been canceled; and claim 20 has been. Thus, claims 4-9, 11-13 and 19-20 are pending.

Claims 4, 7, 9, 14-15 and 17-18 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite.

Claims 1, 2, 4, 5 and 8 stand rejected under 35 U.S.C. 102(e) as being anticipated by Takano et al. (USP 6,434,580).

Claims 10-11, and 14-16 stand rejected under 35 U.S.C. 102(e) as being anticipated by Eastman Chemical Company (WO 01/08031).

Claims 3, 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. (USP 6,434,580).

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. in view of Eastman Chemical.

Claims 12-13 and 17-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eastman Chemical.

As amended, all the pending claims of the subject application comply with all requirements of 35 U.S.C. Accordingly, Applicant requests examination and allowance of all pending claims.

Formal Matters

Proposed amendments to the drawings have been submitted to address various objections set forth in the Rejection. In some instances where the Examiner has objected because the drawings did not show certain reference numbers, the specification has been amended to correct the reference numbers. Accordingly, Applicants respectfully request approval of the proposed drawing changes and that the objection to the drawings be withdrawn.

Applicants have also addressed each of the informalities noted by the Examiner including revising the specification to correct references to Fig. 2 where appropriate, deleting the embedded hyperlink and inserting the application numbers of pending applications that are referenced in the specification. Accordingly, withdrawal of the objections to the specification are respectfully requested.

Oath/Declaration

Applicants respectfully assert that the Declaration under 37 CFR 1.63 submitted for the present application is not defective. The Rejection states that the Declaration is defective because: (1) it does not identify the mailing or post address of the inventor; (2) it does not identify the city and state or foreign country of residence of the inventor and (3) it did not provide the date of execution of the declaration in accordance with either 37 CFR 1.66 or 1.68.

With respect to (1) and (2) applicants note that the rules specifically state that address and residence information may be provided on an application data sheet (ADS) instead of the declaration. See 37 CFR 1.63(c). An ADS was filed in this case and that ADS listed both the address and country of residence of Jeffrey J. Grainger, of the sole inventor of the present application. With respect to (3), applicants note that there is no requirement in the rules that the declarant indicate the date he signed the declaration. The rules require that the declaration identify each inventor by full name, identify the country of citizenship of each inventor, state that the person making the declaration believes the named inventor(s) are the original or first inventor(s) of the invention, identify the application the declaration is for, state that the person making the declaration has reviewed and understood the contents of the application and state that the person making the declaration acknowledges the duty to disclose material information to the USPTO. Applicants respectfully assert that each of these criteria have been met. Accordingly, acknowledgment of the correctness of the declaration is respectfully requested.

The Rejections Under 35 U.S.C. 112

Claim 9 (mistakenly referred to in the rejection as claim 7) stands rejected under 35 U.S.C. 112, first paragraph. In order to expediate prosecution of the present case, claim 9 has been amended to remove the term case data unit from the claim. Accordingly, the rejection of claim 9 on this grounds is respectfully traversed.

Claims 4-7, 9, 14-15 and 17-18 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite.

Claims 4 has been amended to overcome this rejection with respect to claims 4-7 and 9. Accordingly, applicants request the withdrawal of the Section 112 rejection of claims 5-7 and 9.

Regarding claims 14-15 and 17-18, the Rejection states the phrase "includes" renders the claims indefinite because it is unclear whether or not the limitations following the

phrase are part of the claimed invention. For support for this argument, the Rejection recites MPEP §2173.05(d). Applicants do not understand the rejection of these claims on these grounds. Applicants believe claim 14 clearly states the metes and bounds of the claim. Section 2173.05(d) referenced by the Examiner refers to the use of exemplary claim language such as "for example" or "such as". The term "includes" is not exemplary claim language. Accordingly, Applicants respectfully request that this rejection be withdrawn or that the Examiner clarify the grounds for the rejection further.

The Rejections Under Takano et al

Claim 1 and claims 2, 4, 5 and 8, which depend from claim 1, stand rejected under 35 U.S.C. 102(e) as being anticipated by Takano et al. (USP 6,434,580) and claims 3, 6-7 and 9, which also depend from claim 1, stand rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al. (USP 6,434,580) alone or in combination with other references. While Applicants disagree with this rejection, claim 1 has been cancelled to expediate prosecution of the present case. Accordingly, the rejections of these claims in view of Takano is moot. Applicants reserve the right to pursue protection for the invention of claims 1-9 and/or similar inventions in a continuation application.

The Rejections Under Eastman Chemical Company

Claims 10-11, and 14-16 stand rejected under 35 U.S.C. 102(e) as being anticipated by Eastman Chemical Company (WO 01/08031). Specifically, the Rejection states that the Eastman reference teaches "storing a plurality of electronic documents associated with patent applications assigned to a first and second technology developer in a database accessible to a server system (26, 28 (Fig. 3)). Applicants note that the first and second technology developers recited in claim 10, which has now been cancelled in favor of new claim 19, were different entities or companies. In contrast, page 9 of the Eastman reference clearly indicates that work stations 26, 28 are for technologists who work for a single enterprise. See page 9, lines 8-16.

Because claim 10 has been cancelled this rejection is now believed to be moot. New claim 19, however, differs from the Eastman reference in at least this same way. Specifically, claim 19 recites "for a plurality of different and unrelated technology developers, allowing client systems from each such technology developer to create a plurality of invention

disclosures for each respective technology developer; receiving the plurality of invention disclosures for each technology developer at a server system over a public network and storing the plurality of invention disclosures for each technology developer as electronic documents in a database accessible to the server system". Thus, it is respectfully asserted that claim 19, and its dependents, are not anticipated by the Eastman reference.

Moreover, Applicants further assert that claim 19 is not obvious in view of the Eastman reference alone or in combination with any of the other applied references. Similar to Eastman, Takano is also directed to a system for preparing patent applications for a single entity or company. The system in Takano allows for client computers from an outside law firm (e.g., client 200) to interact with the server, but there is no disclosure or suggestion therein that the system can be used to create invention disclosures and patent applications and track other related electronic documents associated with the same for multiple companies or technology developers. Furthermore, neither Eastman or Takano, alone or in combination, suggest other steps recited in claim 19, including but not limited to "maintaining and enforcing rights to electronic documents in the database such that at least some client systems associated with each technology developer in the plurality of technology developers can access selected ones of the electronic documents associated with invention disclosures created for the respective technology developer and such that client systems associated with a particularly technology developer cannot access electronic documents in the database associated with invention disclosures of other unrelated technology developers in the plurality of technology developers". Accordingly, for at least the above reasons Applicants respectfully assert that claim 19 and its dependent claims are allowable over the prior art.

Additionally, Applicants respectfully assert that new claim 20, which replaces previous claim 16, is also patentable over the Eastman and Takano references (alone or in combination) for similar reasons.

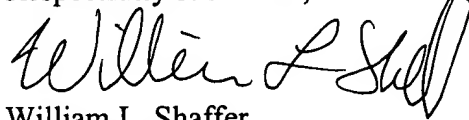
CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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Amdt. dated June 27, 2003
Reply to Office Action of January 3, 2003

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "William L. Shaffer", followed by a large checkmark.

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